



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,235	09/22/2000	Daniel E. Tsai	09640-006001	9932

26161 7590 05/13/2004  
FISH & RICHARDSON PC  
225 FRANKLIN ST  
BOSTON, MA 02110

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/668,235	TSAI, DANIEL E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bunjoo Jaroenchonwanit	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 26-28 and 56-82 is/are pending in the application.
- 4a) Of the above claim(s) 56-57, 59-60, 62, 72-73, 75-76 and 78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 26-28, 58, 61, 63-71, 74, 77 and 79-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Applicant's election without traverse of invention Group I in Paper No. 5 is acknowledged.
2. Newly submitted claims 56-57, 59-60, 62, 72-73, 75-76 and 78 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the similar claims have been restricted and elected without traverse by the applicant.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 56-57, 59-60, 62, 72-73, 75-76 and 78 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 63 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 is a single step claim, i.e., where a step recitation does not appear in combination with another steps, is subject to an undue breadth, a rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible,

Art Unit: 2143

where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 1 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1 and 63 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: the step(s) that correlates the step of matching information with notifying user, such claim's language is vague, unclear whether matching information can construct notifying users as defined in the preamble of the claim.

8. Claims 1 and 63 provide for the use of a method of notifying users, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

9. Claims 2, 3, 10 and other newly added claims, which recite the analogous limitations "the custom information", "the capsule owner", "the time span" and "the intended audience". There is insufficient antecedent basis for this limitation in the claim.

10. Claim 9 recites the limitation "using privacy setting in the capsule" in line 1. There is insufficient antecedent basis for this limitation in the claim. There is no a priori recitation of

Art Unit: 2143

privacy setting in the capsule, such language is unclear and raised a question whether how one can use the setting if it does not exist.

Appropriated corrections are required to the claims and all other similar languages, which may have been oversight by the examiner.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) The invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-14, 26-28, 58, 61, 63-71, 74-77 and 79-82 are rejected under 35 U.S.C. 102(a) as being anticipated by Tso et al (US. 6,047,327).

13. Regarding claims 1, 10 and 63 Tso disclose a method, apparatus and program for distributing information that capable of matching topic of interest in a database with users' preferences or profiles stored in a client device (step 105 Fig.5, 9; Col. 9, line 66-Col. 10, line 3; Col. 13- line 25-Col. 15, line 51; table 3, Col. 18; Col. 22, line 59-Col. 24, line 8).

14. Regarding claims 2, 6, 64, 68 and 80, Tso discloses the information matched is stored in Infobite, e.g., capsule (Col. 10, lines 9-26), having a wrapping field that includes fields that

Art Unit: 2143

contains property characteristics of the capsule, e.g., Infobite topic field, and a content field that contains actual information to be shared or sent, e.g., full text, full video, etc (Fig. 4).

15. Regarding claim 4, Tso discloses the Infobite contains control information such as time span (Fig. 4, validity field).

16. Regarding claims 5, 61, 66 and 67, Tso discloses Infobite contains rule to be matched, information to be filled, and action after matched, (block 103, Fig. 5; blocks 303, -307, fig. 9; table 1, Col. 8; Col. 13- line 25-Col. 15, line 51; table 3, Col. 18).

17. Regarding claims 7, 69 and 82, Tso discloses small fragment of information, having characteristic that allow capsules to locate and obtain further information (Infobite contains links for locating further information, Fig. 4).

18. Regarding claims 8, 11 and 70, Tso discloses, using Infobite for providing news service (Fig. 4) allowing users to make further request (Fig. 5).

19. Regarding claims 9, 12 and 71, Tso discloses Infobite controls user privacy or visibility by using random number to control Infobite for individual user (step 205, Fig. 7).

20. Regarding claims 13-14, Tso discloses the system implementation with wireless and mobile devices (Col. 3, line 49-Col. 4, line 14).

21. Claims 1-4, 6-12, 58, 63-66, 68-71, 74, 79 and 80-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Leonard et al (US. 6,721,784).

22. Regarding claims 1-4, 6-12, 58, 63-66, 68-71, 74, 79 and 80-82, Leonard discloses a message delivery system comprising message wrapped with control information, for identifying owner, audience, rule what to do with the message and expiration time, encryption key for

Art Unit: 2143

privacy. The system sends a message to specific devices over network, in order to receive the message the device at least have to match recipient address with the address of the recipient in the message, thereby inherent (see abstract, figure 3-5, 12; Col. 1, lines 20-45; Col. 2, lines 8-38, 63-Col. 3, line 11; Col. 7, lines 54-65).

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso and applied to claims 1-14 above.

25. Claims 26-28, recites conceptual design, similarly to claims 1-14, Tso discloses the invention substantially, as claimed but it is silent to matching capsule at a server. However, matching or filtering capsule or any form of data packages at any locations, such as at a server or a client, would have been obvious to one of ordinary skilled in the art at the time of the invention was made that was a matter of desirable implementation choice, which produce the same result of filtering specific information based on information contain in the capsule of Infobite or the like.

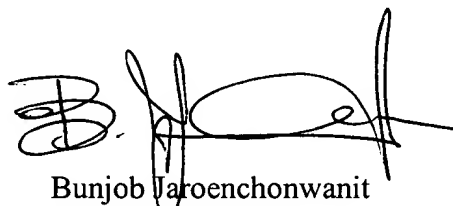
26. Examiner noted that explicitly defining capsule's structure and their functionalities would perhaps help prosecution the application, expeditiously.

Art Unit: 2143

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.



Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
5/12/04